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PATENT
Attorney Docket **045636-5033-US**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Nguyen *et al.***

Provisional Application No. **09/555,640**

Filed: **August 10, 2000**

For: **Erythrovirus and Its Applications**

Group Art Unit: **1648**

Examiner: **Parkin, J.**

U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, Mail Stop Petitions
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

PETITION TO WITHDRAW RESTRICTION REQUIREMENT IN U.S. APPLICATION NO. 09/555,640 UNDER 37 C.F.R. § 1.144

In accordance with 37 C.F.R. § 1.144, Applicants respectfully petition the Commissioner to review and withdraw the restriction requirement, set forth in the first Office Action (PTO Paper No. 8, mailed June 12, 2002) and made Final in the subsequent Office Action (PTO Paper No. 12, mailed February 25, 2003). Under 37 C.F.R. § 1.144 and § 1.181(c) and (d), it is believed no fee is due for this petition. Applicants believe the restriction requirement is in error and should be withdrawn for reasons set forth below.

The Office Action dated June 12, 2002 restricted pending claims 1-14, 16-21, 24-37 into the following groups:

1. Group I, claims 1-6 and 10, drawn to nucleic acids, fragments thereof and primer pairs. Applicants were required to elect one sequence for examination purposes.

2. Group II, claims 7-9, drawn to variant erythrovirus or plasmids encoding the variant.

3. Group III, claims 11-14, 16 and 24-27, drawn to diagnostic methods employing various nucleotide sequences.

4. Group IV, claims 17-20, 28 and 29, drawn to proteins or polypeptide fragments thereof and immunogenic compositions containing said proteins or fragments. Applicants were required to elect one sequence for examination purposes.

5. Group V, claims 21, 30 and 31, drawn to an antibody directed against an erythrovirus variant protein or polypeptide fragment thereof. Applicants were required to elect one antibody for examination purposes.

6. Group VI, claims 32 and 33, drawn to *in vitro* screening methodologies employing erythroviral peptides.

7. Group VII, claims 34 and 35, drawn to *in vitro* screening methodologies employing erythroviral-specific antibodies.

8. Group VIII, claims 36 and 37, drawn to a diagnostic kit comprising various reagents.

Applicants respectfully traverse the restriction requirement. The Office asserted the inventions listed as Groups I-VIII do not relate to a single inventive concept under PCT Rule 13.1 because under PCT Rule 13.1, the groups lack the same or corresponding special technical features. The Office also asserted that a special technical feature is lacking within each of the identified groups and required an election of a single product or single nucleotide sequence for examination.

In their Reply, Applicants elected Group I (claim 1) for examination with traverse in response to the requirement (Reply to Restriction, electing Group I, filed August 12, 2002) and elected SEQ ID NO: 1 with traverse in a Reply to a further PTO communication (filed December 4, 2002). Applicants respectfully traverse the argument that the groups lack the same or corresponding special technical feature.

It is believed that all sequences as set forth in claim 1 are properly examined as a whole for the following reasons. SEQ ID NO: 1 is directed to a mostly full length (about 95%) genomic clone of erythrovirus V9. Other nucleotide sequences are fragments of the nucleotide sequence having SEQ ID NO: 1 and are directed to various V9 antigens, such as for example, the 7.5 kDa protein, the VP1u protein, or are directed to primers for the amplification of sequences

derived from an Erythrovirus type V9, for example. While each of the identified nucleic acid sequences has a different sequence, the identified nucleic acid sequences are part of the sequence of SEQ ID NO: 1 which is the full length genomic clone of Erythrovirus V9. Thus, a search of the Erythrovirus V9 sequence (SEQ ID NO: 1) would encompass the other nucleotide sequences represented by the additional SEQ ID NOs. In view of the fact that a search of SEQ ID NO: 1 would also overlap with a search of the other nucleotide sequences, all the nucleotide sequences have the same special technical feature. Thus, restriction between the individual sequences of claim 1 (and, by analogy, that of Groups IV and V) is inappropriate and should be withdrawn.

The Office also asserted the claimed invention fails to make a contribution over the prior art in view of the document D1 (Shade *et al.*, Journal of Virology 58(3): 921-936 (1986)) cited in the ISA Chapter I Search Report. However, the Examiner has failed to reject any pending claim or claims over the D1 document. In addition, the Examiner stated the erythrovirus genomic segment corresponding to SEQ ID NO: 1 appears to be free of the prior art (PTO Paper No. 12, page 3, "Allowable Subject Matter"). Therefore, the assertion the claimed invention fails to make a contribution over the prior art is clearly in error.

Group II (claims 7-9, directed to a variant erythrovirus or plasmid encoding the variant), Group III (claims 11-14, 16 and 24-27, directed to diagnostic methods employing various nucleotide sequences), Group IV (17-20, 28 and 29, drawn to proteins or polypeptide fragments), Group V (claims 21, 30 and 31, drawn to antibodies directed against proteins or polypeptides), Group VI (claims 32-33, drawn to *in vitro* screening methods), Group VII (claims 34-35, drawn to *in vitro* screening methods employing erythroviral-specific antibodies) and Group VIII (claims 36 and 37) are linked to Group I by the special technical feature of Group I. Therefore, since Groups II-VII share the common technical feature of the nucleotide sequence of Group I, the additional groups should be examined along with the entirety of Group I.

It is respectfully requested that the sequences set forth in Group I be examined as a whole and that the claims of Groups II- VIII be joined to Group I, and examined with, the claims of Group I. Reconsideration and withdrawal of the requirement for election of a single Group and election of a single product within a Group is respectfully requested.

Respectfully submitted,
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RESPONSE TRANSMITTAL FORM

1. Transmitted herewith is a Petition to Withdraw Restriction Requirement in response to the Office Communication dated February 25, 2003 (Paper No. 12).

2. Extension of Time: The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136(a) apply. Applicants do not believe an extension of time is required. However, if Applicants have inadvertently overlooked the need for an extension of time, please consider this a Petition therefor.

3. Fee Calculation (37 C.F.R. § 1.16):

CLAIMS AS AMENDED						
	Remaining		**Previously Paid**	**Extra**	**Rate**	**Total Fees**
Total Claims	**9**	minus	**20**	**0**	$18 each=	0.00
Independent Claims	**1**	minus	**3**	**0**	$84 each=	0.00
First presentation of Multiple Dependent Claim					$280.00	0.00
					Sub-total =	0.00
					Reduction by ½ for filing by a small entity	0.00
					Total Fee =	0.00

4. Constructive Petition: **Except** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and § 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 0-0310.

This paragraph is intended to be a **constructive petition for extension of time** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,
Morgan, Lewis & Bockius LLP

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